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8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
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11 IPS GROUP, INC.,

12 Plaintiff,

13 v.

14 DUNCAN SOLUTIONS, INC. and  
15 DUNCAN PARKING TECHNOLOGIES,  
16 INC.,

16 Defendants.  
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Case No.: 15-cv-1526-CAB (MDD)

**ORDER ON MOTION FOR  
SUMMARY JUDGMENT  
[Doc. No. 177]**

18 This matter comes before the court on Defendants' motion for summary of non-  
19 infringement of U.S. Patent Nos. 7,854,310 ("the '310 patent") and 8,595,054 ("the '054  
20 patent") by the Liberty No Solar Panel and Liberty Next Gen. [Doc. No 177.] The motion  
21 has been fully briefed and the Court finds it suitable for determination on the papers  
22 submitted and without oral arguments in accordance with Civil Local Rule 7.1(d)(1). For  
23 the reasons set forth below, the Court denies the motion.

24 **I. Background**

25 Plaintiff IPS Group, Inc. manufactures solar-powered parking meters and is the sole  
26 owner of '310 and '054 patents. Defendants Duncan Solutions, Inc. ("Duncan Solutions")  
27 and Duncan Parking Technologies, Inc. ("Duncan Parking"), in direct competition with  
28 plaintiff, market the Duncan Liberty® Single-Space Meters to municipalities.

1 In the Second Amended Complaint, it is alleged that Duncan’s products, “including,  
2 but not limited to the Duncan Liberty® Single-Space Meters infringe one or more claims  
3 of the ‘054 the ‘310 Patents. Duncan’s parking meter products are solar powered, fit in  
4 single space parking meter housings, allow cash and credit card/electronic payment, and  
5 can be managed wirelessly.” [Doc. No. 34 at ¶ 15.] Plaintiff alleges claims against  
6 Defendants for direct infringement, willful infringement, inducement of infringement, and  
7 contributory infringement.

8 Plaintiff asserts that Defendants’ Duncan Liberty® Single-Space Meters infringe  
9 Claim 1 of the ‘054 Patent because it includes, among other things, “an upper portion with  
10 a solar panel that charges the power management facility.” [*Id.* at ¶ 31(h).] Claim 1 of the  
11 ‘054 Patent provides that the parking meter device includes an upper portion and a lower  
12 portion, “wherein the upper portion of the parking meter device includes a solar panel that  
13 charges the power management facility<sup>1</sup>.” [Doc. No 34-1, at 12, Col. 6:1-3.]<sup>2</sup> Dependent  
14 Claim 8 states that “[t]he [parking meter as claimed in Claim 1, wherein the solar panel is  
15 located on the rear side of the upper portion of the parking device and is configured to be  
16 visible through a solar panel window of the cover when the cover is closed over the upper  
17 portion.” [*Id.* at Col. 6:36-40.]

18 As to the ‘310 patent, Plaintiff contends that the Duncan Liberty® Single-Space  
19 Meters infringe as least Claim 1 of the ‘310 patent because it includes, among other things,  
20 “[a] solar cell operatively associated with said connections to charge said battery.” [Doc.  
21 No. 34 at ¶ 46(d).] Claim 1 of the ‘310 Patent claims the invention to be a parking meter  
22 that includes “a solar cell operatively associated with said connections to charge” the  
23 rechargeable battery used to power the reader, sensor and device. [Doc. No. 34-2 at 9, Col.  
24 3:57-58.] Further, the claimed parking meter includes “a rear face comprising a surface of  
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27 <sup>1</sup> The power management facility “supplies power to the timer, payment facilitating arrangement, and  
display.” [Doc. No. 34, at Col 5:52-54.]

28 <sup>2</sup> Document and page cites refer to the CM/ECF assigned page designations at the top of the docketed  
document.

1 the cover panel and a surface of the intermediate panel set providing a window aperture via  
2 which said solar cell is exposed to light.” [*Id.* at Col. 4:5-7.] Claim 9 of the ‘310 Patent  
3 describes the module of the parking meter as being comprised of multiple elements,  
4 including an electronic device comprising of “(iv) a solar cell operatively coupled with the  
5 rechargeable battery to charge the rechargeable batter,[sic] the solar cell being disposed to  
6 receive light via the second window.” [*Id.* Col. 4:64-67.]

7 On July 31, 2017, Defendants filed their motion for summary judgment of non-  
8 infringement of U.S. Patent Nos. 7,854,310 and 8,595,054. [Doc. No. 177.<sup>3</sup>] Plaintiff filed  
9 its response in opposition [Doc. No. 207] and Defendants filed their reply [Doc. No. 231].

10 On August 7, 2017, a claim construction hearing and motion hearing was held in this  
11 matter and the related litigation, Case No. 3:17-cv-00632-CAB-MD (“the ’17 case”).  
12 [Doc. No. 186; Doc. No. 66 in the ’17 case.] At the hearing, the undersigned indicated that  
13 the ‘310 and ‘054 patent infringement claims filed against CivicSmart<sup>4</sup> in the ’17 case  
14 should be moved to this case and asked the parties to meet and confer on the topic and  
15 submit a joint proposal to the Court. [Doc. No. 78 in the ’17 case, at 26-30, 45-46.] As of  
16 the date of this Order, the parties have not moved to join CivicSmart nor submitted a joint  
17 proposal, and the Court has not issued an order consolidating the ’17 case claims into this  
18 case.

19 On August 16, 2017, the undersigned granted Defendants’ motion for summary  
20 judgment of non-infringement of the ‘310 patent by Duncan’s Liberty® Single-Space  
21 Meter. [Doc. No. 198.] Accordingly, Defendants’ motion in regards to the ‘310 patent is  
22 moot.

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27 <sup>3</sup> A redacted version of this motion and memorandum in support were filed at Doc. No. 190 of the CM/ECF  
and the exhibits accompanying the motion were filed under seal at Doc. No. 184.

28 <sup>4</sup> In August or so of 2015, Duncan Solutions sold off Duncan Parking Solutions to CivicSmart. Duncan  
Parking Solutions is a wholly-owned subsidiary of CivicSmart. [Doc. No. 78 in the ’17 case, at 25.]

## II. Discussion

Pursuant to Federal Rule of Civil Procedure 56(a) summary judgment is appropriate when “there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law.” However, “courts have ‘no business’ deciding legal disputes or expounding on law in the absence of [] a case or controversy.” *Already, LLC v. Nike, Inc.*, 568 U.S. 85, 90 (2013) (citing *DamillerChrysler Corp. v. Cuno*, 547 U.S. 332, 341 (2006)).

In patent cases, “the existence of case or controversy must be evaluated on a claim-by-claim basis.” *Fox Group, Inc. v. Cree, Inc.*, 700 F.3d 1300, 1307 (Fed. Cir. 2012) (quoting *Jervis B. Webb Co. v. So. Sys., Inc.*, 742 F.2d 1388, 1399 (Fed Cir. 1984)). “[J]urisdiction must exist at all stages of review, not merely at the time the complaint was filed, ... a counterclaimant must show a continuing case or controversy with respect to withdrawn or otherwise unasserted claims.” *Streck, Inc. v. Research & Diagnostic Sys. Inc.*, 665 F.3d 1269, 1282-83 (Fed. Cir. 2012).

In support of their motion, Defendants contend that its’ Liberty No Solar Panel (“NSP”) and Liberty Next Gen (“LNG”), which were offered for sale in June and October 2016 after Plaintiff filed this suit, lack solar panel or solar cells and therefore cannot literally infringe the patents-in-suit. [Doc. No. 190-1 at 9-10.] Additionally, Defendants assert that the NSP and LNG cannot infringe under the judicially-created doctrine of equivalents. [*Id.* at 13-16.] In their reply brief, Defendants make two additional arguments as to why the motion is properly before the Court. First, they argue that because there is a dispute as to whether the NSP and LNG meters are non-infringing alternatives for the purpose of calculating a reasonable royalty the Court has jurisdiction. [Doc. No. 231 at 5-7.] Second, they assert that the Court’s indication that the ‘310 and ‘054 patent infringement claims filed against CivicSmart in the related litigation, Case No. 3:17-cv-00632-CAB-MDD, should be moved to this case, has resulted in the Court having jurisdiction over the issue of whether the NSP and LNG meters infringe these patents. [*Id.* at 7-9.]

1 Plaintiff does not dispute that the NSP or LNG meters do not include either a solar  
2 panel or solar cell. Rather, IPS counters that it has never accused the NSP or LNG meters  
3 of infringement, that neither of these products have appeared in IPS's preliminary or  
4 amended infringement contentions, and it has only accused the "traditional Liberty meter  
5 (with solar panels) of infringement in this case." [Doc. No. 207 at 7.] Plaintiff posits that  
6 as result there is not a justiciable case or a live case or controversy regarding these two  
7 products and this Court, therefore, lacks jurisdiction to decide a motion on unasserted  
8 claims.

9 Here, Plaintiff's SAC alleges infringement of "at least Claim 1 of the '054 Patent"  
10 because it includes, among other things, "an upper portion with a solar panel that charges  
11 the power management facility." [Doc. No. 34 at ¶ 31(h).] Plaintiff's Amended  
12 Infringement Contentions, dated January 17, 2017, refer to the Duncan Liberty® Single-  
13 Space Meters ("the Liberty® Meter") and the MST™ and M5™ Single-Space Smart Parking  
14 Meters. [Doc. No. 221-17 at 9-15.] Further, the preamble to the Claim Chart Comparing  
15 Claim 1 of '054 patent to the Liberty® Meter states:

16 at this time IPS Group alleges that the Accused Products include at least  
17 Duncan's Liberty® Meters. These contentions therefore analyze  
18 infringement by the Liberty® Meter. However, later discovery in this case  
19 may reveal that additional products made, used, sold, offered for sale, or  
20 imported by DPT and/or DSI infringe this claim. IPS Group reserves the right  
to supplement its contentions to add additional accused products based on  
subsequent discovery.

21 [Id. at 64.] The claim chart itself includes multiple instances where the solar panel is  
22 identified as an element of the accused products. For example, Plaintiff notes that "Duncan  
23 advertised that the Liberty® Meter is '[s]olar powered with rechargeable battery for  
24 extended life'.... The battery pack is continuously recharged by two solar panels mounted  
25 below the front and rear LCD displays. . . . The mechanism will automatically switch back  
26 to the primary batteries once the solar panels have sufficiently recharged the battery pack."  
27 Id. at 73. See also Id. at 77, 90-92, 98-100, 101, 103, 104, 107-08. In sum, not only are  
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1 the LNG and NSP meters not specifically identified anywhere within the infringement  
2 contentions or SAC, the general Liberty® Meters accused of infringing include solar panels  
3 which means that the LNG and NSP do not fit within this definition.

4 In light of these circumstances, the Court concludes that Plaintiff has not alleged or  
5 contended that the LNG and NSP meters are devices that infringe the patents-at suit. As a  
6 consequence, the Court **DENIES AS MOOT** Defendants' motion for summary judgment  
7 on the LNG and NSP meters. The Court further concludes that Plaintiff is estopped from  
8 asserting the LNG and NSP meters infringe the '310 patent. At this time, the Court offers  
9 no opinion as to whether the LNG and NSP meters are non-infringing alternatives.  
10 Whether they constituted an alternative would depend on facts not before the Court, such  
11 as whether solar powered capability was driving demand for the product. This issue has  
12 not been properly briefed and is best addressed in relation to damages opinions and  
13 testimony.

14 **III. Conclusion**

15 Based on the foregoing, the Court **DENIES AS MOOT** Defendants' motion for  
16 summary judgment [Doc. No. 177].

17 It is **SO ORDERED**.

18 Dated: October 2, 2017



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20 Hon. Cathy Ann Bencivengo  
21 United States District Judge  
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